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OFFICE OF PETITIONS

In re Application of
Walker et al.
Application No. 09/706,088
Filed: November 3, 2000
Attorney Docket No. 032026:0486

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 35 U.S.C. § 154(B)(3)(B)(II)," filed March 18, 2004. Applicants request that the patent term adjustment be corrected from twenty-four (24) days to either three hundred thirty-nine (339) or eighty-five (85) days. In part, applicants request that the patent term adjustment indicated in the patent be increased for the patent issuing more than three years after the filing date of the application.

The request for reconsideration of the patent term adjustment at the time of mailing of the notice of allowance is **DISMISSED**, except as to the request for time for over 3 years to issue, which is held in abeyance until the patent issue date is established.

Applicants are given **thirty (30) days** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

A decision on the request for reconsideration of the patent term adjustment indicated in the patent on the basis that the patent issued more than three years after the application filing date is being held in abeyance until after the actual patent date. Applicants are given **TWO (2) MONTHS** from the issue date of the patent to request reconsideration of the patent term adjustment indicated in the patent on this basis. Applicants may seek reconsideration on this basis without payment of the fee.

On December 24, 2003, the Office mailed the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 24 days. Applicants agree with the period of adjustment of 215 days for Office delay in mailing a first Office action under 35 U.S.C. 132. Applicants dispute the reduction totaling 191 days for applicant delay in responding to the non-final Office action mailed October 8, 2002. Applicants contend that using the certificate of mailing date, the PTA should have only been reduced by 61 days, not 68 days, for the

initial response mailed March 10, 2003, but received March 17, 2003. Further, applicants contend that the response received March 17, 2003 was fully responsive. Thus, the PTA should not have been further reduced by 123 days for the response filed July 18, 2003. (Likewise, applicants argue that any reduction based on the filing of the second response should be calculated based on the certificate of mailing date of July 15, 2003).

Applicants' arguments have been considered, but are not persuasive. First, of all, applicants' attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, the certificate of mailing dates of the responses filed March 17, 2003 and July 18, 2003 were properly not taken into account in calculating patent term adjustment. Thus, the reduction of 68 days for applicant delay in filing their initial response to the non-final Office action is correct.

In addition, the further reduction of 123 days is correct. The record does not support a conclusion that the Notice of Non-responsive Amendment mailed June 4, 2003 was mailed in error. Further, applicants responded to the Notice on the merits on July 18, 2003. Thus, it is concluded that the reduction of 123 days pursuant to § 1.704(c)(7) for submission of a reply correcting an omission was proper.

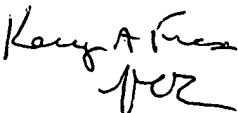
It is further noted that on July 18, 2003, applicants also filed an Information Disclosure Statement. This IDS did not include a § 1.704(d) statement. Accordingly, if the PTA were not reduced by 123 days for submission of the response on July 18, 2003, pursuant to § 1.704(c)(8), the PTA would have been reduced by 123 days for submission of the IDS.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is twenty-four (24) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Publishing Division has been advised of this decision. The application is being processing into a patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.



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